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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/960,548
Filing Date: September 20, 2001
Appellant(s): IGAKURA, TOMOHIRO

Andrew A. Phillips
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on April 19, 2011 appealing from the Office action mailed on January 19, 2011.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-17. However, the status of claims being appealed by Appellant is different from the status of claims being rejected. i.e., Appellant merely appeals claims 2-6 and 8-17.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

Appellant submitted claims 2-6 and 8-17 to be reviewed on Appeal, which is different from the status of claims 1-17 that were rejected in the Office action mailed on January 19, 2011.

Because Appellant did not explicitly withdraw claims 1 and 7 before appeal or after final, as such, Examiner maintains all of the 35 U.S.C. *rejections for claims 1-17 filed on January 19, 2011 and recorded at section (9) Grounds of Rejection.*

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,560,631	Ishihara et al.	5-2003
5,109,511	Nitta et al.	4-1992

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter. The latter three categories define "things" or "products" while the first category defines "actions" (i.e., inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) ("The term process' means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.").

Federal courts have held that 35 U.S.C. 101 does have certain limits. First, the phrase "anything under the sun that is made by man" is limited by the text of 35 U.S.C. 101, meaning that one may only patent something that is a machine, manufacture, composition of matter or a process. See, e.g., *Alappat*, 33 F.3d at 1542, 31 USPQ2d at 1556; >In re< *Warmerdam*, 33 F.3d >1354,< 31 USPQ2d >1754,< 1757 (Fed. Cir. 1994). Second, 35 U.S.C. 101 requires that the subject matter sought to be patented be a new and useful" invention. Accordingly, a complete definition of the scope of 35 U.S.C. 101, reflecting Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent.

The subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena. While this is easily stated, determining whether an applicant is seeking to patent an abstract idea, a law of nature or a natural phenomenon has proven to be challenging. These three exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable. See, e.g., *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) ("idea of itself is not patentable, but a new device by which it may be made practically useful is"); *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939) ("While a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be."); *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759 ("steps of locating' a medial axis, and creating' a bubble hierarchy . . . describe nothing more than the manipulation of basic mathematical constructs, the paradigmatic abstract idea").

The courts have also held that a claim may not preempt ideas, laws of nature or natural phenomena. The concern over preemption was expressed as early as 1852. See *Le Roy v. Tatham*, 55 U.S. 156, 75 (1852) ("A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right."); *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 132, 76 USPQ 280, 282 (1948) (combination of six species of bacteria held to be nonstatutory subject matter).

Accordingly, one may not patent every "substantial practical application" of an idea, law of nature or natural phenomena because such a patent would "in practical effect be a patent on the [idea, law of nature or natural phenomena] itself." *Gottschalk v. Benson*, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972).

Claims 1 and 7 are rejected under 35 U.S.C. 101, because the claimed subject matter is directed to non-statutory subject matter.

As to claim 1, applicant seemed try to recite a utility to manage files at the preamble of the claim, however, the body of the claim lacks of any physical device or machine to really execute the claimed functional steps which renders the claimed system as a software per se.

As to claim 7, the claimed method not only lacks any physical device or computer device to perform the claimed managing files function, but also failed to transform the claimed subject matters into a specific state of article. Thereby, this claim merely direct to non-statutory which failed to fall into anyone of the four categories - process, machine, manufacture, or composition of matter as specified under 35 U.S.C. 101. In re Bilski.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 7, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, applicant recited the claims as following:

"A file managing system for managing files comprising: a manager for managing a plurality of files having the same file title but different contents as separate files, and for managing a plurality of files having the same content but different titles as a single file."

For the claim set forth above, it is first noted by the examiner that applicant failed to define the metes and bounds of the claimed contents and the links of the claimed content, titles, single file and the plurality of files. Further, It seems that applicant try to map the claimed subject matters by referencing to P. 1, lines 6 -13, P. 15, lines 15-25, P. 16, lines 19-25 and P. 30, lines 26-27 of instant specification (see P. 4, Appeal Brief filed on 04/06/2009), however, the important links between the claimed "a manager" and these specified excerpts are either missing or unclear, as such, it renders the claimed file manager and its associated functional steps as indefinite.

Regarding Claims 7, applicant recited the claims as following: "A file managing method for managing files, wherein a plurality of files having the same file title but different contents are managed as separate files, while also managing a plurality of files having the same content but different titles as a single file."

Again, applicant seemed try to map the claimed subject matters by referencing to P. P. 1, lines 6 -13, P. 15, lines 15-25, P. 16, lines 19-25 and P. 30, lines 26-27 of

instant specification (see section D of P. 11-12, Appeal Brief filed on 04/06/2009), however, the important links of the claimed subject matters such as “managing a plurality of files having the same content but different titles as a single file” and the specified excerpts are unknown. In addition, the claim language use the term “wherein” but the instant specification fails to provide actual steps to perform or limit these claims to a particular structure, thus, this term renders the claimed scope to be indistinct. See *In re Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005).

Due to the ambiguous nature of instant invention, the following art rejection is as to the best of the examiner ascertain. Further, the claims and only the claims form the metes and bounds of the invention. “Office personnel are to give claims their broadest reasonable interpretations in light of the supporting disclosure, *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claims are not read into the claims. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)” MPEP p 2100-8, c2, I 45-48; p 2100-9, c1, I 1-4). The examiner has full latitude to interpret each claim in the broadest reasonable sense. The examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7 and 12, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,560,631 issued to Ishihara et al. (hereinafter referred as Ishihara).

As to claims 1 and 7, Ishihara discloses a file management system with means and method to manage files [e.g., Abstract] comprising:

managing a plurality of files having the same file title but different contents as separate files [e.g., the data files in a conventional file management system when they are shared by a plurality of computer can be managed to have the same file name and path name (or titles) but completely different contents in reference to Fig. 5 and col. 6, lines 21-26]; and

managing a plurality of files have the same content but different titles as a single file [e.g., the use of file process execution controller (e.g., unit 174, Fig 1 and associated text) which makes the cached copies of remote data and program files (e.g., col. 7, lines 6-25) per executes a single file analytical procedure to create a work area has the same shared file content but different file titles via different linking to a unique file naming

conversion format (e.g., the intermediary data files have naming format specified at col. 6, lines 58 - 62), wherein the file analytical procedure itself is a single file in a naming convention format at col. 6, lines 55-57].

As to claims 2 – 3 and 12, Ishihara discloses a file management system [e.g. Abstract, col. 2, lines 15 –36] with means and method to perform the following steps as claimed by applicant:

a) a GUI interface [e.g., the GUI interface of each terminal station at col. 9, lines 39-42] coupled to the data processor [e.g., the Process Execution Unit 3, Fig. 1] and system users, wherein, the GUI interface in response to the user's request / input will register or retrieve registered files [e.g., col. 12, lines 1-7, Fig. 8, col. 11, lines 54-61; Fig. 15 and associated text];

b) a memory unit including a correspondence table [e.g., the tables: 172aa, Fig. 9, 172ab, Fig. 10, 172ac of Fig. 11 and 173a, Fig. 12], in which correspondence relationships of file titles, file ID and managing IDs are recorded [e.g., col. 9, lines 55 – col. 10, line 32]; and a file memory [e.g., the Cache management table 173a, Fig. 12], in which managing IDs and files are recorded [col. 10, lines 42-49];

c) a data processor [e.g., the process execution unit 3, Fig. 1, the multiprocessors, col. 5, lines 9-14] including:

means for producing a new managing ID and registering, in the file memory, the new managing ID and a file to be registered [e.g., , Abstract, col. 12, lines 1 – 16, Fig.(s)15-16 and associated texts];

means for deleting the managing ID and the registered file from the file storage for duplicated files [col. 2, lines 8-10, col. 4, lines 3-22, S41-S43, Fig. 19; col. 14, lines 39-46];

means for retrieving the file memory with managing IDs to get corresponding files [e.g., col. 2, lines 29-36, Fig. 20 and associated texts];

means for sending the obtained files to a file output unit [e.g., the CORBA architecture, col. 11, lines 54-57];

means for comparing a file content to be registered with the registered file in the memory [e.g., col. 13, lines 12-16];

means for registering the file ID, file title and new managing IDs [e.g., the step S1, Fig. 15];

means for updating a correspondence table, if a same content file has been registered in the memory [e.g., col. 12, lines 1-16; col. 13, lines 19-28];

means for retrieving a corresponding table [e.g., the created link of 172a, 173a, S32, Fig. 18; col. 14, lines 47-55];

d) the file output unit sending out, to the file request input unit, the file corresponding to the requested file title and ID from the input unit as delivered from the data processor [e.g., col. 10, lines 33 – 41].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-6, 8-11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,560,631 issued to Ishihara et al. (hereinafter referred as Ishihara), in view of U.S. Patent No. 5,109,511 issued to Nitta et al. (hereinafter referred as Nitta).

As to claims 4 and 13, Ishihara discloses all the features as recited in claims 2 and 3, except he fails to specifically teach the memory unit including hash tables in which relationships of hash value of files and managing IDs are recorded, such that the processor can use the hash table to retrieve, register and verify the contents of the associated files as claimed by applicant.

However, Nitta discloses a memory unit including hash tables as claimed by applicant for a multi-task processor [col. 3, line 40-45] to manipulating the associated data elements in file system as claimed by applicant [e.g., Abstract, the units: 20, 30, etc. Fig. 1; Fig.(s) 4-12 and associated texts].

Ishihara and Nita are analogous art and both in the same endeavor to facilitate the managing of shared files in the multiprocessor environment or the multi-task processing environment [e.g., Ishihara: col. 7, lines 6-19; Nita: Title, Abstract]. Therefore, with the teachings of Ishihara and Nitta in front of him/her, an ordinary skilled

artisan at the time the invention was made would be motivated to modify the file management system Ishihara with the hash tables as taught by Nitta, because by doing so, the combined system processor will be able to management of data suitable for high-speed access to a large quantity of files without lock operation under the multiprocessor environment or the multi-task processing environment [e.g., Nitta: Abstract, lines 14-18]. Furthermore, the use of counter data hold in the hash tables for confirming that during the processing of registration of a certain data element by a certain process the processing of registration of another data element having the same home position as the certain data element is not performed in parallel by another process. The provision of the registration counter makes it possible to prevent double registration of the same data element into the hash table. Also, since one registration counter is provided not for the whole of the hash table but for each table entry, the probability of occurrence of collision in access to the registration counter can be reduced [Nitta: col. 2, lines 16 – 42].

As to claims 5 and 14, the combined system discloses all the features as claimed in claims 4 and 13, it further discloses that the hash tables are each provided for each file title, and the hash table retrieving means decides, if no same title file as the file title of the any retrieved file has been registered in the file memory, that no hash table retrieval result is present, and retrieves, if a same title file has been registered in the file memory, the hash table corresponding to the file title of the same title file with the hash

value of the pertinent file to be registered used as a key value [e.g., Nitta: Fig. 12 and associated text].

As to claim 6 and 15, the combined system discloses all the features as claimed in claims 4 and 13, the combined system further discloses that only a single hash table is provided for all file titles [e.g., the hash table 30, Fig. 1].

As to claims 8-11 and 9-16, these claims recited the same subject matters as claims 2-6 and 13-15 in form of method, since the features of these claims have been disclosed or suggested by the combined system as discussed above, hence these claims are rejected for the same reason.

(10) Response to Argument

The Applicant's Invention:

A file management system includes a data processor for managing files.

Appellant's piece-meal interpretation and arguments filed on April 19, 2011 have been fully considered but they are not persuasive.

Initially, appellant arguments under "GROUND OF REJECTION TO BE REVIEWED ON APPEAL" consist of sections: A and B that are listed as following:

- A. Claims 2-3 and 12 are not anticipated by Ishihara"; and
- B. Claims 4-6, 8-11, and 13-17 are patentable over Ishihara in view of Nitta.

In response to the arguments of section A. listed above, the examiner first noted that the arguments cited in Page 18, starting from 3rd paragraph to Page 20, 1st paragraph are corresponding to the limitations of claims 1 and 7 that are moot and not under the consideration for appealing, because appellant specifically requested "'GROUND OF REJECTION TO BE REVIEWED ON APPEAL" are for claims 2-3, 4-6 and 8-17 respectively. In addition, appellant specifically discarded claims 1 and 7 from claims as listed in Appendix A.

Further, the examiner disagreed with appellant's arguments for claims 2, 3 and 12 that "at no point does Ishihara disclose producing and recording in the file memory a new managing ID for a new file if no file has the same content as any of the files to be registered."

In reply to the above arguments, the examiner first noted that appellant failed to clearly define the metes and bounds of the claimed file managing ID, the type of the

claimed file memory or any specific technique to register the claimed file. As such, these claims are widely open for reasonable art interpretation.

Further, the examiner respectfully directs appellant's attention to the excerpts and figures disclosed by Ishihara. For example, Ishihara has clearly disclosed his invention as following:

"A distributed data processing system uniformly managing distributed data and program files. **A resource management database associates identifiers of resource files** to be used in analytical processes with their respective storage locations. **The identifiers should be unique in the distributed environment, so that all resource files will be uniquely distinguished from each other by using their identifiers.** When requesting execution of a particular analytical process, **the identifiers specify resource files necessary for the process.** A process execution unit in the system **first creates** a work area, which can also be used **to store intermediate data files created** during the execution. **The resource management database is consulted to know the locations of necessary resource files, and creates links in the work area to reach those files.** The process execution unit executes the requested analytical process while making access to the resource files via the links in the work area." (Abstract)

Ishihara further disclosed the following:

"FIG. 15 is a flowchart which shows how to set up necessary functions to prepare for a specific analytical process. The user initiates this preparatory process by entering

an appropriate command to the process execution controller 174 through the GUI controller 171.” (col. 11, lines 66 – col. 12, lines 3)

“(S1) **The process execution controller 174 activates warehouse servers 181 to 183, disposed in the plurality of computers, and registers various data to them.** After that, the warehouse servers 181 to 183 manage the registered data.” (col. 12, lines 4 – 7 & Fig. 16)

“(S2) The process execution controller 174 **activates the resource management server 172 to collect and record information** about what the warehouse servers 181 to 183 have in their respective local storage.” (col. 12, lines 8 – 11)

“(S3) The process execution controller 174 then **activates the cache management server 173. Note that there are no cached files at the initial stage. Each time a cached file is created in the warehouse servers 181 to 183, the cache management server 173 updates its cache management table 173a for further management.**” (col. 12, lines 12 – col. 12, lines 16)

As set forth above, Ishihara clearly disclosed his invention comprising a resource management database and at least one processing executions unit [e.g., unit: 3, Fig. 1 or 174, Fig. 16] for producing [e.g., per creating a work area of a distributed source files at Abstract, lines 10 -11] and recording [e.g., storing the crated intermediate data files at Abstract, lines 11-12] in the file memory [i.e., in the created work area at Abstract, lines 11-12] a new managing ID for a new file [i.e., a newly created unique file identifier for

distributing source files at Abstract, lines 2 -7], if no file has the same content as any of the files to be registered [e.g., In a specific GUI file set up processing for a user file analytical editing as shown by Fig. 15, during the initial setting up stage, the work area has no cached files and no same contents at all. Additionally, each time a cached file is created, the warehouse servers (e.g., as shown in 181 – 183, Fig. 16) of the file management system register the created files in a work area (e.g., 183e, Fig. 16) & col. 12, lines 1 – 16].

Moreover, Ishihara further clearly disclosed that the newly crated file identifiers are stored and registered in work area memories such as each one of the whole raw contents which identify a unique entry as shown in units: 173a, Fig. 12 and 240, Fig. 20. Thereby, in contrary to appellant's arguments, Ishihara clearly anticipated the claimed limitations.

In reply to the arguments of section B, it is noted that Appellant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. As such, the examiner maintains the 35 U.S.C. 101, 112 second paragraph, 102(e) and 103(a) rejections on record.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Susan Chen/

Examiner, Art Unit: 2154

Conferees:

/John E Breene/

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